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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,403	07/27/2001	Gerold Tebbe	011105	9180

22876 7590 06/13/2002

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EXAMINER

LEWIS, KIM M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 06/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/586,403

Applicant(s)

RIVE, RUSSELL S.

Examiner

Kim M. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2001 and 27 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 11 and 14 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Action*.

DETAILED ACTION

Response to Amendment

1. The preliminary amendment filed on 7/27/01 has been received and made of record in the application file wrapper. The amendments to the claims have been entered. Claims 1-14 are pending in the instant application.

Specification

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

3. The disclosure is objected to because of the following informalities:

Throughout the specification the applicant refers to the claims. The examiner objects to such recitations because the claim numbering may not be preserved.

Appropriate correction is required.

Claim Objections

4. Claims 1-12 are objected to because of the following informalities:

Claims 1, line 2, delete "on said base layer";

Claims 2-12, "Plaster" should read --The plaster--. Appropriate correction is required.

5. Claim 12 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot reference two sets of claims to different features. See MPEP § 608.01(n). Accordingly, the claim 12 has not been further treated on the merits.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 5, 6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, the claim is indefinite in that the applicant further limits the working layer. However, the working layer is not positively recited.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 6 recites the broad recitation "drying agents", and the claim also recites "such as kieselguhr, aluminum oxide and the like" which is the narrower statement of the range/limitation. Claim 6 also recites the broad recitation "pharmaceutical substances", and then recites "such as, for example,

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pharmaceuticals acting on the skin, e.g. anti-inflammatory pharmaceuticals, pharmaceutical substances which are supplied to the body percutaneously, which is the narrower statement of the range/limitation. Additionally, claim 6 recites the broad recitation "skin care products", and then recites "e.g. soothing oils", which is the narrower statement of the range/limitation. As to claim 10, the claim recites the broad recitation "the thickness of the base layer (10) amounts to between 20 and 100 μm ", and then recites "preferably between 30 and 60 μm ", which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,120,325 ("Dow, Jr.").

As regards claim 1, Dow, Jr. discloses a backing layer having top and bottom sides, an adhesive layer applied to the bottom side of the backing layer, and a non-toxic pigmented composition coated onto or embedded into said top side of said backing layer (col. 1, lines 38-49).

As regards claims 2, and 4, and the rough external surface, note the disclosure of the folds and grooves to simulate the texture of human skin (col. 2, lines 40-44).

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10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,797,494 ("Zaffroni").

As regards claim 1, Zaffroni discloses a bandage for the administration of a drug by controlled metering through microporous material. More specifically, Zaffroni discloses a backing layer (21), a reservoir layer (working layer) (32) arranged on said backing layer, and an adhesive layer (23). The applicant should note that the backing layer is capable of accepting a cosmetic preparation since nothing in Zaffroni precludes coating the backing layer.

11. Claims 1, 4, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,905,174 ("Smith").

As regards claims 1 and 7, Smith discloses an adhesive bandage with a transparent film backing, in which the backing is provided with a series of cosmetic preparations in the form of flesh-colored markings (printing-ink layer) (col. 1, line 65-col. 2, line 29 and col. 4, lines 51-56).

As regards claim 4, Smith discloses at col. 2, lines 8-54, col. 4, lines 51-50 and in the figures, bandages to blend in well with the skin (*i.e.*, show a skin imprint).

As regards claim 8, Smith discloses the printing-ink layer between the transparent backing and the adhesive layer (col. 4, lines 57-60).

12. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,586,971 ("Newman").

As regards claim 1, Newman discloses an invisible bandage assembly comprising an adhesive base layer (12) having a top surface (13) capable of

receiving a cosmetic preparation (15).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr. in view of U.S. Patent No. 4,807,753 ("Goldstein").

Regarding claim 14, Dow, Jr. substantially discloses all features of the claim except a set comprising a plurality of bandages of various sizes. However, Goldstein teaches it is conventional in the art to provide a set comprising a plurality of bandages in order to fit various sized wounds.

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In view of Goldstein, it would have been obvious to one having ordinary skill in the art provide the bandages of Dow, Jr. in a set comprising various sizes in order to fit various sized wounds.

As to the bandage being punched out of a planar material, the applicant should note that in a product claim, the method by which the product is formed, is a non-distinctive characteristic which does not serve to distinguish.

16. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman.

As regards claim 4, Newman substantially discloses all features of the claim except that the external surface of the backing layer has been given a surface treatment or a surface coating to make the external surface lipophilic or hydrophilic. However, Newman discloses that the backing layer is constructed from a paper tape (col. 3, line 13-col. 4, line 29), which is inherently hydrophobic. Such paper tape equates to a structural equivalent.

As such, one having ordinary skill in the art would have been motivated to use a structural equivalent to arrive at the same outcome because use of a paper tape would make it easier to manufacture the bandage.

Additionally, the examiner contends that the bandage made of paper tape would perform equally well as the instant invention.

17. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaffroni.

As regards claims 5 and 6, Zaffroni substantially discloses all features of the claims except a microencapsulated substance. However, Zaffroni teaches active

substances in the form of drugs that treat skin disorders (col. 2, lines 47-53)
impregnated in the bandage.

The examiner contends that the use of microencapsulated drugs or drugs in other forms would have been an obvious design choice to one having ordinary skill in the art absent a critical teaching.

18. Claims 9 –11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith.

As regards claim 9, Smith discloses plasticized vinyl chloride film for use in constructing the backing layer.

Smith fails to teach the backing is constructed from rubber. Absent a critical teaching and/or a showing of unexpected results derived from constructing the backing layer from rubber, the examiner contends that the selection of material for the backing layer is an obvious design choice, which does not patentably distinguish applicant's invention.

As regard claim 10, Smith fails to teach that the thickness of base layer amounts to between 20 and 100 μm , preferably 30 to 60 μm . Absent a critical teaching and/or a showing of unexpected results derived from providing the thickness of the backing layer in an amount between 20 and 100 μm , preferably 30 to 60 μm , the examiner contends that the thickness of the backing layer is an obvious design choice which does not patentably distinguish applicant's invention.

Additionally, the examiner further contends that one having ordinary skill would

have been motivated to provide a thin backing layer in order to the backing layer inconspicuous.

As regards claim 11, Smith fails to teach that the adhesive layer consists of an adhesive that cures after application of the bandage to the skin. The examiner contends that it would have been *prima facie* obvious to select any well known adhesive to secure the bandage to the skin.

The applicant is reminded that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. *In re Leshin*, 227 F.2d197, 125 USPQ 416 (CCPA 1960).

Allowable Subject Matter

- ✓ 19. Claims ^{3 and 13 are} objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is 703.308.1191. The examiner can normally be reached on Mondays to Thursdays from 5:30 am to 4:00 pm.

The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.3590 for regular communications and 703.305.3590 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0858.

A handwritten signature in black ink, appearing to read 'Kim M. Lewis', is positioned above the printed name.

Kim M. Lewis
Primary Examiner
Art Unit 3761

kml
June 6, 2002